



MAIL STOP AF

PATENT

Customer No. 22,852

Attorney Docket No. 05725.0807-00000

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
 Isabelle ROLLAT-CORVOL et al.) Group Art Unit: 1617
)
 Application No.: 09/719,101)
) Examiner: WANG, Shengjun
 Filed: February 23, 2001)
)
 For: COSMETIC COMPOSITION) Confirmation No.: 4969
)
) COMPRISING AT LEAST ONE TACKY)
) POLYMER AND AT LEAST ONE)
) FIXING POLYMER)

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Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action mailed March 28, 2007, and the Advisory Action mailed August 22, 2007, the time period for response to which having been extended to August 28, 2007, by the Petition for Two-Month Extension of Time and fee-payment filed concurrently herewith, Applicants respectfully request panel review of this application. This Request is being filed in conjunction with a Notice of Appeal under 37 C.F.R. § 41.31 and appeal fee payment. No amendments are filed with this Request.

The arguments raised below are not a comprehensive set of Applicants' objections to the Final Office Action, but represent a summary of the prosecution history, which Applicants specifically incorporate by reference herein. Applicants

reserve the right to raise additional arguments on appeal, including arguments that could have been raised herein.

Claims 38-106 are pending. Claims 59, 61-68, 70-77, 80-82, and 85-87 are withdrawn from consideration as directed to non-elected subject matter.

Claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 stand rejected under the judicially created doctrine of obviousness-type double patenting over claims 1-41 of U.S. Patent No. 6,346,234 to Rollat et al. ("the '234 patent"), in view of EP 0551 749 to Lee et al. ("*Lee*"). In the Advisory Action mailed August 22, 2007, the Examiner indicates that the Terminal Disclaimer filed in this application on July 27, 2007, has been received and is under review. Applicants submit that the Terminal Disclaimer has rendered the double patenting rejection moot and respectfully request its withdrawal.

Claims 38-43, 45-50, 69, 78, 79, 83, 84, and 88-106 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Applicants disagree with this rejection for at least the following reasons, as well as the reasons of record.

In the Office Action mailed March 28, 2007, the Examiner maintained the rejection under § 112, first paragraph, asserting that "[t]he claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The claims are directed to composition comprising polymers which are solely defined by physical properties." Final Office Action at 3.

M.P.E.P. § 2163 clearly instructs that “[t]he written description requirement for a claimed genus may be satisfied through sufficient description of a representative number of species by actual reduction to practice, reduction to drawings, or by disclosure of relevant, identifying characteristics, i.e., **structure or other physical and/or chemical properties, by functional characteristics coupled with a known or disclosed correlation between function and structure, or by a combination of such identifying characteristics**, sufficient to show the applicant was in possession of the claimed genus.” M.P.E.P. § 2163 II.A.3(a).ii), internal citations removed and emphasis added. Here, pages 4-6 of the present specification provide guidance on how to determine the maximum peeling force F_{\max} and the energy for separation $ES_{(M/V)}$ of the “tacky polymer” presently claimed, which are physical characteristics and **not** mere “functional limitations,” as alleged by the Examiner. In addition, the present specification provides embodiments of the “tacky polymer,” such as, for example, branched sulphonic polymers or (meth)acrylic ester polymers on page 6, lines 21-23, guidance on how to form the branched sulphonic polyester and the (meth)acrylic ester, and specific examples thereof at pages 7-12.

Accordingly, the rejection under 35 U.S.C. § 112, first paragraph, is improper and Applicants respectfully request its withdrawal.

Claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 stand rejected under 35 U.S.C. § 103(a) over *Lee* in view of WO 95/18191 to Miller et al. (“*Miller*”). Applicants disagree with this rejection for at least the following reasons, as well as the reasons of record.

Contrary to the Examiner’s allegations in the Office Action mailed March 28, 2007, *Miller* cannot be considered analogous art to the present application, nor can

Miller be considered analogous art to *Lee*. In the Advisory Action mailed August 22, 2007, the Examiner continues to assert that “in view the cited references as a whole, the issue presented to the artisan, *Miller* reference is pertinent to the issue: tachy [sic] polymer.” Advisory Action at 2. This assertion is in error and clearly fails to meet the requirements for pertinence laid out by *In re Clay*, 966 F.2d 656, 659, 23 USPQ2d 1058, 1060-61 (Fed. Cir. 1992), which states that “a reference is reasonably pertinent if, even though it may be in a different field from that of the inventor’s endeavor, it is one which, because of the matter with which it deals, logically would have commended itself to an inventor’s attention in considering his problem.”

Miller is directed to repulpable hot-melt adhesive compositions suitable for use on paper products, nonwoven assemblies, and other disposable products. Required properties for adhesive compositions according to *Miller* are said to include “high bond strength under conditions of shock, stress.” *Miller* at 2, lines 5-7 and 15-17. The present application is directed to a hairstyling composition having “good cosmetic properties, in particular in terms of disentanglement, softness and feel.” Specification at 3, lines 8-19. Applicants respectfully submit that *Miller*, which is not in Applicants’ field of endeavor, would not have logically commended itself to Applicants’ attention because the matter with which it deals does not provide an adequate solution to the particular problem with which Applicants were concerned.

Similarly, *Miller* cannot be considered analogous art to *Lee*, which is directed to hair spray compositions with “low stickiness” and “good combing characteristics.” *Lee* at 2. Because of the divergent properties highlighted above, i.e., high bond strength under conditions of shock and stress, *Miller* would not have logically commended itself

to persons of ordinary skill in the art wishing to modify hair spray compositions according to *Lee*.

Miller is neither in the field of the present invention, nor is it in the field of *Lee*'s invention. In addition, *Miller* would not have logically commended itself to persons of ordinary skill in the art wishing to modify compositions according to *Lee*. Thus, considering the cited references as a whole, one of ordinary skill in the art would not have been led to combine the teachings of *Lee* and *Miller* in an attempt to arrive at the presently claimed invention. Accordingly, the rejection under 35 U.S.C. § 103(a) is improper and Applicants respectfully request its withdrawal.

For at least the foregoing reasons and those presented in Applicants' prior responses, Applicants respectfully request reconsideration of the application and the timely allowance of all pending claims. Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By: 

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Dated: August 28, 2007